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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,124	04/20/2007	Klaus Kulper	101769-370 KGB	4140
27384	7590	01/03/2011		
Briscoe, Kurt G. Norris McLaughlin & Marcus, PA 875 Third Avenue, 8th Floor New York, NY 10022			EXAMINER HUANG, CHENG YUAN	
			ART UNIT	PAPER NUMBER
			1787	
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			01/03/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/590,124	KULPER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	CHENG HUANG	1787	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20101202</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Claim Objections**

1. Claim 13 is objected to because of the following informalities: Claim 13 recites “joint” in the last line of the claim. It appears “joint” should read “joining”. Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
4. Claim 13 recites “a second laminating adhesive joint the separate layers C and B”. While Applicants point to Fig. 3 for support, there does not appear to be support for the recited limitation.

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 3-8, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terry et al. (U.S. Patent Application Publication No. 2005/0180704).

8. Regarding claim 1, Terry et al. teaches a tape for bandaging cable harnesses (See Abstract), comprising a backing with a first outer layer A inherently having a first side (support 16, paragraph [0032]), wherein the first side of the first outer layer A connected to a separate layer C (open layer 10', paragraph [0032]) over an entire area of the first side of the first outer layer A (Fig. 4), the outer first layer A is composed of a scrim or woven fabric (paragraph [0039]), and the layer C being composed of a textile having an open but stable three-dimensional structure (paragraphs [0033] and [0034]).

9. Terry et al. does not explicitly teach wherein the layer C is firmly connected on an open side to a second separate outer layer B over the entire area of a first side of the outer layer B, wherein the outer layer B is composed of a velour, scrim, woven fabric or formed-loop knit.

10. However, Terry et al. teaches a support layer composed of woven fabric or scrim (paragraph [0039]). It would have been obvious to one of ordinary skill in the art at the time of

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the invention to provide a support layer on open layer 10' for added protection or mechanical strength. The duplication of parts is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. Providing a second support would have achieved expected results such as protection or mechanical strength. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. MPEP 2144.04 (VI) B. In re Harza, 124 USPQ 378, 380 (CCPA 1960). The resulting structure of Terry et al. teaches wherein the layer C is firmly connected on an open side to the second separate outer layer B over the entire area of a first side of the outer layer B.

11. While there is no disclosure that the tape is abrasion-resistant and noise-suppressing as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

12. It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. abrasion-resistant and noise-suppressing, recited in the present claims does not result in a structural

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difference between the presently claimed invention and the prior art invention and further that the prior art structure which is a tape identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

13. Regarding claim 3, given that Terry et al. teaches wherein first outer layer A comprises polyester (paragraph [0033]) and layer C comprises polyester or propylene (paragraph [0041]) which are materials identical to those of the presently claimed invention, it is expected that the backing of Terry et al. inherently possesses the abrasion resistance of the presently claimed invention.

14. Regarding claim 4, Terry et al. teaches wherein the layer C is a three-dimensional nonwoven structure (paragraphs [0033] and [0034]).

15. Regarding claim 5, Terry et al. teaches wherein the layer C has a thickness of 0.1 to 6 mm (paragraph [0033]).

16. Regarding claim 6, the resulting structure of Terry et al. teaches further comprising a mechanical bond formation joining, without adhesive, the separate layers A, B and C to form an assembly (paragraph [0049]).

17. Regarding claim 7, the resulting structure of Terry et al. teaches wherein the layers A, B, and C comprise wear-resistant polymers (paragraphs [0033] and [0041]) given that the presently claimed invention discloses that wear-resistant polymers include polyesters and polyolefins (paragraph [0048]).

18. Regarding claim 8, Terry et al. teaches wherein the backing is coated at least on one side with a self-adhesive layer (adhesive 22, paragraph [0045]), wherein the layer C intrinsically has a thickness defined between a first side and a second side opposite to the first side.

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19. Terry et al. does not explicitly teach wherein the entire thickness of layer C is located between the first side of the layer A and the self-adhesive layer.

20. However, Terry et al. teaches a self-adhesive layer (adhesive 22, paragraph [0045]). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an adhesive layer on open layer 10' for added adhesion. The duplication of parts is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. Providing a second adhesive would have achieved expected results such as adhesion. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. MPEP 2144.04 (VI) B. In re Harza, 124 USPQ 378, 380 (CCPA 1960). The resulting structure of Terry et al. teaches wherein the entire thickness of layer C is located between the first side of the layer A and the self-adhesive layer.

21. Regarding claim 13, the resulting structure of Terry et al. teaches further comprising a first laminating adhesive joining the separate layers A and C to form an assembly (adhesive 22, paragraph [0045]).

22. Terry et al. is silent as to a second laminating adhesive joining the separate layers C and B.

23. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a second laminating adhesive between separate layers B and C in order to better adhere the layers.

24. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a laminating adhesive between separate layers B and C for increased adhesion. The duplication of parts is generally recognized as being within the level of ordinary skill in the art,

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absent unexpected results. Providing a second adhesive would have achieved expected results such as additional adhesion. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. MPEP 2144.04 (VI) B. In re Harza, 124 USPQ 378, 380 (CCPA 1960).

25. Furthermore, regarding claim 13, Applicants admit in paragraph [0030] of the US-PG Pub, that it is well known in the art to use laminating adhesives in order to create a stable, potentially load-bearing assembly. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include laminating adhesives in between separate layers A and C and separate layers C and B to create a stable, potentially load-bearing assembly.

26. Regarding claim 14, the resulting structure of Terry et al. teaches wherein the self-adhesive layer is made of an acrylate adhesive (paragraph [0046]).

### **Response to Arguments**

27. Applicants' arguments filed 02 December 2010 have been fully considered but they are not persuasive.

28. Applicants amended claim 1 to include the limitations of cancelled claim 2 and amended claim 13 to include a second laminating adhesive.

29. Applicants argue that the addition of a second support layer in the tape of Terry would have been "inoperable for Terry's intended uses" and point to the Abstract and paragraphs [0014], [0029], [0053], and [0057] to demonstrate that the open layer of the tape of Terry is in direct contact with the cable or fiber.



30. However, the Abstract and paragraphs [0014], [0029], and [0057] do not state that the open layer of the tape of Terry is required to be in direct contact with the cable or fiber.

Paragraph [0053] of Terry describes only an embodiment. Further, in light of paragraph [0057] and Fig. 12 of Terry, it is clear that additional layers may be present, including layers in between the open layer of Terry and the cable. Therefore, the duplication of a second support layer on open layer 10' of Terry would not render the invention of Terry inoperable given that Terry discloses various layers in between the open layer of Terry and the cable.

### Conclusion

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1787

December 30, 2010

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787

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